

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* TAKASHI BANDO, MASATAKA YASU and KIICHI YAMATSUTA

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Appeal No. 2001-0159  
Application 08/936,724

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HEARD: APRIL 24, 2002

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Before OWENS, TIMM and NAGUMO, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

*DECISION ON APPEAL*

This appeal is from the final rejection of claims 1, 3, 4, 6, 9, 11, 15 and 16, which are all of the claims remaining in the application.<sup>1</sup>

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<sup>1</sup>Claims 15 and 16 (amendment filed September 20, 1999, paper no. 9) have not been clerically entered. The examiner should have these claims entered.

### *THE INVENTION*

The appellants' claimed invention is directed toward a synthetic resin-covered heat insulating/sound absorbing inorganic fiber mat. Claim 1 is illustrative:

1. A synthetic resin film covered heat insulating/sound absorbing material of inorganic fibers which comprises:

an inorganic fiber mat, having longer and shorter sides and two synthetic resin films which cover front and rear surfaces and both side surfaces along the direction of the longer side of the inorganic fiber mat, wherein the synthetic resin film at the front side and the synthetic resin film at the rear side, along the direction of the longer side of the mat, respectively have extensions which extend by 10 mm to 200 mm from both sides along the direction of the shorter side of the inorganic fiber mat, transverse to the direction of the longer side of the mat, and which are bonded with a hot melt adhesive at mutually opposing portions so that both end surfaces along the shorter side of the inorganic fiber mat are covered with the synthetic resin films, and the inorganic fiber mat is bonded to one of the synthetic resin films and the synthetic resin films are mutually bonded in a discontinuous manner in the direction of the shorter side of the inorganic fiber mat so that air communicates through unbonded portions of the synthetic resin films, and further extensions extending from both sides along the direction of the longer sides of the inorganic mat.

### *THE REFERENCES*

Gilman	2,435,347	Feb. 3, 1948
Sack et al. (Sack)	3,369,547	Feb. 20, 1968
Sens	3,546,846	Dec. 15, 1970
Sowinski	4,436,204	Mar. 13, 1984
Hall et al. (Hall)	5,545,279	Aug. 13, 1996

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Shioda et al. (JP '849)<sup>2</sup> 6-79849 Mar. 22, 1994  
(Japanese published unexamined patent application)

#### *THE REJECTIONS*

The claims stand rejected under 35 U.S.C. § 103 as follows: claims 1, 4, 6 and 15 over JP '849 in view of Sens, Sowinski and optionally Sack, and claims 3, 9, 11 and 16 over these references further in view of Gilman or Hall.

#### *OPINION*

We affirm the rejection of claims 3, 9 and 11, and reverse the rejection of claims 1, 4, 6, 15 and 16.

The appellants state that claims 1, 3, 4, 6, 9 and 11 stand or fall together, as do claims 15 and 16. We therefore limit our discussion of the affirmed rejection to one claim, i.e., claim 3. See *In re Ochiai*, 71 F.3d 1565, 1566 n.2, 37 USPQ2d 1127, 1129 n.2 (Fed. Cir. 1995); 37 CFR § 1.192(c)(7)(1997). As for the reversed rejections, we need to address only claims 1 and 16.

#### *Rejection of claim 1*

The appellants do not argue that the examiner has not established a *prima facie* case of obviousness of the invention recited in claim 1. Instead, the appellants argue that they have

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<sup>2</sup> Citations herein to JP '849 are to the English translation thereof which is of record.

shown evidence of commercial success (brief, page 5). This evidence includes a declaration by Iwashita (filed September 20, 1999, paper no. 10) and an update of that declaration (filed February 15, 2000, paper no. 15), wherein the appellants' market share for the product of claim 1 is shown to have increased from 35.9% to 45.0% between the first quarter of 1996 and the third quarter of 1999. The declaration also shows that the total sales of the product did not increase during this period. Iwashita explains that sales were flat due to poor economic conditions in Japan, and that the increased market share was due to customer satisfaction, especially in preventing scattering of fibers, and was not due to any special advertising campaign. The evidence also includes a declaration by Hayashi (filed February 15, 2000, paper no. 15), a customer. Hayashi states that his company has purchased Mat Ace Fullpack glass wool insulating materials since May 1996 from the appellants' assignee, Asahi Fiber Glass Company, Ltd., "because, unlike glass wool insulating materials from other manufacturers, the glass wool insulating materials of Asahi Fiber Glass have all surfaces covered with synthetic resin films, and there is no scattering of fibers and no uncomfortable irritating feeling when the products are used in a house building

site" (page 1).<sup>3</sup> In addition, the evidence includes a declaration by Kawakami (filed February 15, 2000, paper no. 15), a customer, wherein Kawakami states that his company has purchased glass wool insulating materials from the appellants' assignee since around May 1996 because (pages 1-2):

3. Since the heat insulating material is so formed that all 6 faces, i.e.[sic], a front surface, a rear surface, both side surfaces along a longer side and both side surfaces along a shorter side, of the glass wool mat are covered with synthetic resin films, there is reduced skin irritation for workers due to the scattering of glass fibers during working. So far, we often felt the irritating feeling with heat insulating material produced by other manufacturers because both sides along a shorter side of the product were not covered with synthetic resin films.

4. Further, we have employed the Asahi Fiber Glass heat insulating material because Asahi Fiber Glass was the first to commercialize glass wool heat insulating material for housing, having such feature, which is suited for use at an actual construction site.

The examiner states that "it is acknowledge [sic] that the data presented in Appellant's declaration appear to show an overall upward trend in Appellant's market share" (answer, page 8). The examiner argues that the JP '849 covered mat has

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<sup>3</sup>In view of the appellants' presentation of the Iwashita declarations in conjunction with the Hayashi and Kawakami declarations (brief, sentence bridging pages 7 and 8), we consider the Mat Ace Fullpack referred to in the Hayashi and Kawakami declarations to be the product of claim 1 for which market share data are reported in the Iwashita declarations.

the feature which the customer declarants stated was their basis for purchasing the claimed covered mat, i.e., the mat is covered by synthetic resin film on all sides (page 4; figure 1), and that the appellants have not shown a nexus between the increased sales and a recited characteristic of the claimed invention which distinguishes it over the JP '849 covered mat (answer, page 9). The JP '849 covered mat differs from that recited in the appellants' claim 1 in that the JP '849 films are bonded by heat sealing (pages 4-6) rather than by hot melt adhesive.

The appellants argue that the JP '849 covered mat was not commercially available because the JP '849 heat bonding does not produce a commercially viable product (brief, pages 8-9). This argument is supported by 1) the appellants' specification, wherein the problems with the JP '849 covered mat are discussed (page 3, line 6 - page 5, line 20), 2) the declaration of Hayashi wherein he states that "unlike glass wool insulating materials from other manufacturers" the appellants' mat has all surfaces covered (page 1), and 3) the declaration of Kawakami wherein he states that the shorter sides of the heat insulating material of other manufacturers were not covered with synthetic resin films (pages 1-2). Hence, the evidence of record indicates that the increased market share was due to an element of the claimed

invention which was not a characteristic of the commercially available products. The examiner's argument (answer, page 9) that because the JP '849 mat is covered on all sides, the appellants' increased market share must be due to another factor such as price differential, an efficient distribution network, brand loyalty or an incentive such as a warranty, is not supported by the evidence of record.

The examiner's *prima facie* case of obviousness is based upon the disclosure in JP '849 of a heat-bonded covered mat, the teaching by Sens of use of either heat bonding or adhesive to join synthetic resin flaps around a glass fiber mat (col. 6, lines 40-54), the teaching by Sowinski of using a hot melt adhesive for sealing the edges of a polyethylene film used to form a tubular container for joint compound slurry (col. 1, lines 4-7; col. 2, line 46 - col. 3, line 7), and the teaching by Sack of using either heat sealing or adhesives or cements to seal the periphery of bandages (col. 1, lines 25-26; col. 3, lines 69-72; col. 4, lines 37-42). This *prima facie* case is sufficiently weak that it is overcome by the above-discussed evidence of commercial success. Accordingly, we reverse the rejection of claim 1 and claims 4, 6 and 15 which depend therefrom.

*Claim 3*

The appellants do not challenge the *prima facie* case of obviousness of claim 3 (brief, page 10). Instead, the appellants rely upon the above-discussed evidence of commercial success for overcoming the *prima facie* case of obviousness. The data showing increased market share, however, are limited to the product recited in claim 1 (sentence preceding table A in each Iwashita declaration). There is no evidence of increased market share of the product recited in claim 3 which, unlike that recited in claim 1, is covered by a single synthetic resin film rather than by two synthetic resin films. Because the appellants have not challenged the *prima facie* case of obviousness of claim 3 or overcome it with evidence of secondary considerations, we affirm the rejection of that claim and claims 9 and 11 which stand or fall therewith.

*Claim 16*

Claim 16 depends from claim 3 and recites that the hot melt adhesive is a sticking hot melt adhesive.

The examiner argues that sticking hot melt adhesives were known, and that it is well within the purview of choice in the art to chose from known adhesives (answer, pages 7-8). For a *prima facie* case of obviousness to be established, however, the



teachings from the prior art itself must appear to have suggested the claimed subject matter to one of ordinary skill in the art. See *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976). The mere fact that the prior art could be modified as proposed by the examiner is not sufficient to establish a *prima facie* case of obviousness. See *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). The examiner has not established that the applied prior art itself would have led one of ordinary skill in the art to use a sticking hot melt adhesive to bond a resin film on a fiber mat. Accordingly, we reverse the rejection of claim 16.

#### DECISION

The rejection under 35 U.S.C. § 103 of claims 1, 4, 6 and 15 over JP '849 in view of Sens, Sowinski and optionally Sack, is reversed. The rejection under 35 U.S.C. § 103 over these references further in view of Gilman or Hall is affirmed as to claims 3, 9 and 11, and reversed as to claim 16.

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No time period for taking any subsequent action in  
connection with this appeal may be extended under 37 CFR  
§ 1.136(a).

*AFFIRMED-IN-PART*

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TERRY J. OWENS	)	
Administrative Patent Judge	)	
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	)	
	)	BOARD OF PATENT
CATHERINE TIMM	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
MARK NAGUMO	)	
Administrative Patent Judge	)	

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